

1 VERA M. ELSON, State Bar 156327
2 velson@wsgr.com
3 DALE R. BISH, State Bar 235390
4 dbish@wsgr.com
5 CHRISTOPHER D. MAYS, State Bar 266510
6 cmays@wsgr.com
7 JONATHON JOANNIDES, State Bar 311260
8 jjoannides@wsgr.com
9 WILSON SONSINI GOODRICH & ROSATI PC
10 650 Page Mill Road
11 Palo Alto, CA 94304-1050
12 Telephone: (650) 493-9300
13 Facsimile: (650) 565-5100
14
15 EDWARD G. POPLAWSKI, State Bar 113590
16 epoplawski@wsgr.com
17 OLIVIA M. KIM, State Bar 228382
18 okim@wsgr.com
19 NEIL N. DESAI, State Bar 286405
20 ndesai@wsgr.com
21 WILSON SONSINI GOODRICH & ROSATI PC
22 633 West Fifth Street, Suite 1550
23 Los Angeles, CA 90071
24 Telephone: (323) 210-2900
25 Facsimile: (866) 974-7329
26
27 Attorneys for Plaintiff
28 MINERVA SURGICAL, INC.

Deborah E. Fishman, State Bar No. 197584
deborah.fishman@apks.com
ARNOLD & PORTER KAYE SCHOLER
LLP
3000 El Camino Real, Building 5, Suite 500
Palo Alto, CA 94306
Telephone: (650) 319-4500
Facsimile: (650) 319-4700

Ryan J. Casamiquela SBN 228559
Ryan.Casamiquela@apks.com
ARNOLD & PORTER KAYE SCHOLER
LLP
Three Embarcadero Center, 10th Floor
San Francisco, CA 94111-4024
Phone: (415) 471-3100
Fax: (415) 471-3400
ryan.casamiquela@apks.com

Matthew M. Wolf (*pro hac vice* pending)
Matthew.Wolf@apks.com
Marc A. Cohn (*pro hac vice* pending)
Marc.Cohn@apks.com
ARNOLD & PORTER KAYE SCHOLER
LLP
601 Massachusetts Ave., NW
Washington, DC 20001-3743
Phone: (202) 942-5000
Fax: (202) 942-5999

*Attorneys for Defendants
Hologic, Inc. and Cytac Surgical Products*

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

21 MINERVA SURGICAL, INC., a Delaware
22 corporation,
23 Plaintiff,
24 v.
25 HOLOGIC, INC., a Delaware corporation; and
26 CYTYC SURGICAL PRODUCTS, LLC, a
Massachusetts limited liability company,
27 Defendants.

) CASE NO. 3:17-cv-02013-JD
)
)
) **JOINT CASE MANAGEMENT
STATEMENT**
)
) Date: September 7, 2017
) Time: 10 a.m.
) Place: Courtroom 11, 19th Floor
) Judge: Hon. James Donato
)
)
)

1 Plaintiff Minerva Surgical, Inc. (“Minerva”) and Defendants Hologic, Inc. and Cytac
 2 Surgical Products, LLC (collectively, “Hologic”) jointly submit this JOINT CASE
 3 MANAGEMENT STATEMENT pursuant to the Clerk’s Notice dated July 5, 2017 (Dkt. 30), the
 4 Reassignment Order Setting CMC dated May 11, 2017 (Dkt. 21), the Standing Order for Civil
 5 Cases Before Judge James Donato dated January 5, 2017, and Civil Local Rule 16-9.

6 **1. Jurisdiction & Service**

7 *The basis for the court’s subject matter jurisdiction over plaintiff’s claims and defendant’s
 8 counterclaims, whether any issues exist regarding personal jurisdiction or venue, whether
 9 any parties remain to be served, and, if any parties remain to be served, a proposed
 10 deadline for service.*

11 This is an action for patent infringement arising under the patent laws of the United
 12 States, Title 35 of the United States Code, including 35 U.S.C. § 271 *et seq.* The Court’s subject
 13 matter jurisdiction is based on 28 U.S.C. §§ 1331 and 1338(a). Venue is proper in this Court
 14 pursuant to 27 U.S.C. §§ 1391(b)-(c) and 1400(b). The parties are currently unaware of any
 15 issues regarding personal jurisdiction or venue. No parties remain to be served.

16 **2. Facts**

17 *A brief chronology of the facts and a statement of the principal factual issues in dispute.*

18 Minerva filed its Complaint against Hologic in this action on April 11, 2017. Dkt. 1.
 19 Notably, the parties were already embroiled in an earlier-filed suit brought by Hologic against
 20 Minerva in the District of Delaware. Specifically, on November 6, 2015, Hologic filed a
 21 Complaint for Patent Infringement alleging that Minerva’s Endometrial Ablation System
 22 infringes U.S. Patent Nos. 6,872,183, 8,998,898, and 9,095,348 in the District of Delaware.
 23 *Hologic, Inc. v. Minerva Surgical Inc.*, Case No. 1:15-cv-01031-JFB- SAF, ECF No. 1 (D. Del.)
 24 (“Delaware Litigation”). In the Delaware Litigation, the parties are currently engaged in expert
 25 discovery and a jury trial is scheduled for July 16, 2018.

26 In its Complaint in this action, Minerva alleges that Hologic directly infringes at least
 27 claim 13 of U.S. Patent No. 9,186,208 (“the ’208 patent”) by making, using, offering for sale,
 28 selling, and/or importing into the United States the NovaSure ADVANCED®—which was
 released in February 2017—in violation of 35 U.S.C. § 271(a). Minerva further alleges that
 Hologic indirectly infringes the ’208 patent by inducing third parties, such as Hologic’s

1 customers, to use the NovaSure ADVANCED® in violation of § 271(b). Minerva seeks
 2 damages and injunctive relief (both preliminary and permanent) for the alleged infringement, as
 3 well as a finding that this case is exceptional and thus an award of Minerva's attorneys' fees and
 4 costs. In addition, Minerva contends that Hologic's infringement has been and continues to be
 5 willful, wanton, deliberate and/or willfully blind, thereby making this an exceptional case under
 6 § 285 and entitling Minerva to enhanced damages under § 284.

7 On May 4, 2017, Hologic filed their Answer and Counterclaims (Dkt. 13), which denied
 8 Minerva's allegations, asserted several affirmative defenses and counterclaims, and contends that
 9 Minerva is not entitled to any relief. Minerva filed its Answer to Hologic's Counterclaims on
 10 May 25, 2017. Dkt. 22.

11 **3. Legal Issues**

12 *A brief statement, without extended legal argument, of the disputed points of law, including
 reference to specific statutes and decisions.*

13 The principal disputed legal issues are:

- 14 • Whether Minerva is entitled to preliminary injunction;
- 15 • The proper construction of any disputed claim terms in the '208 patent;
- 16 • Whether Hologic directly infringes any claims of the '208 patent under 35 U.S.C. §
 271(a) and/or indirectly infringes any claims of the '208 patent under § 271(b);
- 17 • Whether the alleged infringement by Hologic has been willful, wanton, deliberate
 and/or willfully blind;
- 18 • Whether the '208 patent is invalid under §§ 102, 103, and/or 112;
- 19 • Whether Minerva's claims are barred, in whole or in part, by any defense raised by
 Hologic;
- 20 • Whether Minerva is entitled to a permanent injunction under § 283;
- 21 • Whether Minerva is entitled to damages as a result of alleged infringement of any
 claims of the '208 patent, and if so, the amount, under § 284;
- 22 • Whether this case is exceptional under § 285, entitling either party to attorneys' fees
 or costs.

1 **4. Motions**

2 *All prior and pending motions, their current status, and any anticipated motions.*

3 The following are pending motions at this time:

4

- Minerva's Motion for Preliminary Injunction (Dkt. 35);
- Two motions requesting leave for *pro hac vice* admission of two counsel for Hologic (Dkt. 17 & 18).

5 *Minerva's Position:* Minerva anticipates filing motions for summary judgment on issues that may include infringement and validity.

6 *Hologic's Position:* Hologic believes that the '208 patent-in-suit is not infringed, and that an early summary judgment on non-infringement would resolve this case. Hologic also believes that the '208 patent-in-suit is invalid, and that an early summary judgment on this issue would resolve this case as well.

7 **5. Amendment of Pleadings**

8 *The extent to which parties, claims, or defenses are expected to be added or dismissed and a proposed deadline for amending the pleadings.*

9 *Minerva's Position:* Minerva proposes that the deadline for joining parties and amending 10 the pleadings without leave of Court should be October 27, 2017. *See Appendix A* (Minerva's 11 Proposed Case Schedule).

12 *Hologic's Position:* Hologic proposes that the deadline for joining parties and amending 13 the pleadings should be set after the Court's ruling on Minerva's motion for a preliminary 14 injunction. *See Appendix B* (Hologic's Proposed Case Schedule).

15 The parties agree that they may amend the pleadings upon a showing of good cause after 16 this deadline has passed.

17 **6. Evidence Preservation**

18 *A brief report certifying that the parties have reviewed the Guidelines Relating to the 19 Discovery of Electronically Stored Information ("ESI Guidelines"), and confirming that 20 the parties have met and conferred pursuant to Fed. R. Civ. P. 26(f) regarding reasonable 21 and proportionate steps taken to preserve evidence relevant to the issues reasonably 22 evident in this section. See ESI Guidelines 2.01 and 2.02, and Checklist for ESI Meet and 23 Confer.*

1 The parties have reviewed the ESI Guidelines and have met and conferred regarding
 2 reasonable and proportionate steps taken to preserve evidence relevant to the issues reasonably
 3 evident in this section.

4 **7. Disclosures**

5 *Whether there has been full and timely compliance with the initial disclosure requirement
 of Fed. R. Civ. P. 26, and a description of the disclosures made.*

6 Minerva's Position: Minerva's proposes to exchange initial disclosures pursuant to FED.
 7 R. CIV. P. 26 on September 29, 2017.

8 Hologic's Position: Hologic proposes to exchange such disclosures after resolution of
 9 Minerva's pending motion for a preliminary injunction.

10 **8. Discovery**

11 *Discovery taken to date, if any, the scope of anticipated discovery, any proposed limitation
 12 or modifications of the discovery rules, a brief report on whether the parties have
 13 considered entering into a stipulated e-discovery order, a proposed discovery plan
 pursuant to Fed. R. Civ. P. 26(f), and any identified discovery disputes.*

14 The parties have commenced taking discovery relating to Minerva's Preliminary
 15 Injunction Motion pursuant to the August 15, 2017 Order re [39] Stipulation with Proposed
 16 Order. Dkt. 40. The parties are considering a stipulated ESI Order and a stipulated Protective
 17 Order.

18 A. *Changes to the timing, form, or requirement for disclosures (Fed. R. Civ. P.
 19 26(f)(3)(A)):*

20 The parties propose changing the timing for initial disclosures pursuant to FED. R. CIV. P.
 21 26(a). See Appendices A & B.

22 B. *The subjects on which discovery may be needed (Fed. R. Civ. P. 26(f)(3)(B)):*

23 Discovery may include Rule 26 disclosures, patent disclosures under the local rules,
 24 written discovery, depositions, and non-party discovery.

25 C. *Any issues about disclosure, discovery, or preservation of electronically stored
 26 information, including the form or forms in which it should be produced (Fed. R.
 27 Civ. P. 26(f)(3)(C)):*

28 The parties are working on an ESI order. The parties had previously negotiated an ESI
 order in the Delaware Litigation, and anticipate that the form in which materials should be

1 produced will be consistent with the manner in which the parties had previously produced
 2 materials.

3 *D. Any issues about claims of privilege or of protection as trial-preparation materials*
 4 *(Fed. R. Civ. P. 26(f)(3)(D)):*

5 The parties contend that, due to the ongoing Delaware Litigation, a high volume of
 6 attorney-client privileged or work-product documents will be responsive to the parties' document
 7 requests in this action. As stated below, the parties need not log such documents on a privilege
 8 log so long as the documents are directly related to the pursuit of any claims or defenses in the
 9 Delaware Litigation. Other exclusions from the requirement to log privileged or work-product
 10 documents and information are set forth below.

11 *E. Changes that should be made to the limitations on discovery (Fed. R. Civ. P.*
 12 *26(f)(3)(E)):*

13 The parties have set forth limitations on written discovery, depositions, and other aspects
 14 of discovery below. The parties reserve their right to seek modification to the scope of discovery
 15 at a later date. The parties' proposals on discovery limitations are set forth below:

16 *i. Requests for Production of Documents and Things*

17 The parties agree to a maximum of 30 requests for production by each side. The requests
 18 during the preliminary injunction do not apply to this maximum. This limitation may be
 19 expanded with leave of Court upon a showing of good cause.

20 *ii. Interrogatories*

21 The parties agree to a maximum of 20 interrogatories by each side. The interrogatories
 22 during the preliminary injunction do not apply to this maximum. This limitation may be
 23 expanded with leave of Court upon a showing of good cause.

24 *iii. Requests for Admissions*

25 The parties agree to a maximum of 40 requests for admission by each side. This
 26 limitation does not include requests to authenticate documents for purposes of FED. R. EVID.
 27 803(6). This limitation may be expanded with leave of Court upon a showing of good cause.

28

1 *iv. Fact Depositions*

2 The parties agree that each party is limited to a maximum of 60 hours of deposition time,
 3 which includes individual, Rule 30(b)(6), and third-party depositions, excluding depositions
 4 taken during the preliminary injunction phase. Witnesses deposed during the preliminary
 5 injunction phase can be deposed again during fact discovery of the overall case. This limitation
 6 may be expanded with leave of Court upon a showing of good cause.

7 *v. Expert Depositions*

8 The parties agree to meet and confer in good faith regarding limitations on expert
 9 depositions during the expert discovery phase, after expert reports have been served.

10 *vi. Service by Email*

11 The parties consent in writing to service by email to outside counsel of record in
 12 accordance with FED. R. CIV. P. 5(b)(2)(E) (except in the case of documents required to be filed
 13 with the Court electronically, the service of which is governed by the Local Rules, documents
 14 that are too voluminous for email, and productions governed by the ESI Order) in PDF or similar
 15 format (*e.g.*, single-page .TIFF files with load data).

16 *vii. Discoverability of Expert Materials*

17 Draft reports, notes, and outlines of draft reports shall not be subject to discovery in this
 18 case, nor shall any such drafts, notes, or outlines of draft reports that the testifying expert
 19 prepared in other cases be subject to discovery in this case. Such draft reports, notes, outlines, or
 20 any other writings leading up to an issued report(s) in this litigation or the Delaware Litigation
 21 are considered attorney work product and are exempt from discovery. In addition, the discovery
 22 of materials provided to a testifying expert and the expert's communication in connection with
 23 his or her role as a testifying expert in this litigation shall be limited to subject matter actually
 24 relied upon by the testifying expert in his or her final report, trial or deposition testimony, or any
 25 opinion in this case, or relating to the expert's potential bias. Notwithstanding the foregoing, an
 26 expert who is also a fact witness may be subject to discovery concerning his or her relevant
 27 factual knowledge.

28

1 *viii. Claims of Privilege*

2 Parties shall not be required to identify in their respective privilege log any document or
 3 communication protected by the attorney-client privilege, work product immunity, or other
 4 privilege or protection that were created or are dated on or after the filing of this lawsuit, which
 5 absent this provision, the party would have been obligated to so identify on said privilege log.
 6 Parties need not log any document or communication protected by the attorney-client privilege,
 7 work product immunity, or other privilege or protection generated after the filing of the
 8 complaint in the Delaware Litigation that are directly related to the prosecution of the claims or
 9 defenses asserted in the Delaware Litigation.

10 Pursuant to FED. R. EVID. 502(d), the mere production of a privileged or work-product-
 11 protected document, whether inadvertent or otherwise, is not a waiver of privilege or protection
 12 from discovery in this case or in any other federal or state proceeding. For example, the mere
 13 production of privileged or work-product-protected documents in this case as part of a mass
 14 production is not itself a waiver in this case or any other federal or state proceeding. Information
 15 that contains privileged matter or attorney work product shall be immediately returned if such
 16 information appears on its face to have been inadvertently produced. If a party determines that a
 17 privileged document was produced, it shall promptly request that the privileged document be
 18 returned or destroyed. A party receiving such a request shall return, destroy, and/or confirm the
 19 deletion of all copies of any such privileged document within seven business days after the
 20 request is made.

21 **9. Class Actions**

22 *If a class action, a proposal for how and when the class will be certified.*

23 Not applicable.

24 **10. Related Cases**

25 *Any related cases or proceedings pending before another judge of this court, or before
 another court or administrative body.*

26 There are no related cases or proceedings. However, there is the Delaware Litigation, a
 27 patent infringement action involving the same parties, but different patents, which was brought
 28 by Hologic against Minerva in the District of Delaware on November 6, 2015, currently pending

1 before Honorable Joseph F. Bataillon. *Hologic, Inc. et al. v. Minerva Surgical, Inc.*, Case No.
 2 1:15-cv-01031-JFB-SRF (D. Del.). In addition, Minerva filed a petition for *inter partes* review
 3 on April 11, 2016 challenging the patentability of claims 1-15 of U.S. Patent No. 6,872,183, a
 4 Hologic patent asserted in the Delaware Litigation. The PTAB instituted *inter partes* review of
 5 the claims on October 6, 2016, and the review is currently pending. *Minerva Surgical, Inc. v.*
 6 *Hologic, Inc.*, Case No. IPR2016-00868 (P.T.A.B.). Minerva also filed a petition for post-grant
 7 review on November 2, 2016 challenging the patentability of claims 1-19 of U.S. Patent No.
 8 9,247,989, another Hologic patent asserted in the Delaware Litigation. The PTAB instituted
 9 post-grant review of the claims on May 10, 2017, and the review is currently pending. *Minerva*
 10 *Surgical, Inc. v. Hologic, Inc.*, Case No. PGR2017-00002 (P.T.A.B.).

11 **11. Relief**

12 *All relief sought through complaint or counterclaim, including the amount of any damages*
 13 *sought and a description of the bases on which damages are calculated. In addition, any*
party from whom damages are sought must describe the bases on which it contends
damages should be calculated if liability is established.

14 Minerva seeks entry of judgment finding that Hologic infringes the '208 patent, both
 15 directly and indirectly, and that infringement has been willful. Minerva also seeks preliminary
 16 and permanent injunction. In addition, Minerva seeks monetary damages and interest, including
 17 lost profits and/or reasonable royalty, prejudgment and post-judgment interest. Minerva also
 18 seeks enhanced damages. In order for the damages to be calculated, Minerva needs discovery
 19 from Hologic. Minerva further seeks entry of judgment finding that this is an exception case and
 20 an award of attorneys' fees and costs. Minerva seeks any other relief available under applicable
 21 law.

22 Hologic requests that the Court enter judgment as follows: (1) that the claims set forth in
 23 Minerva's Complaint are dismissed with prejudice; (2) that the asserted claims of the '208 patent
 24 are invalid; (3) that Hologic has not and do not infringe, directly or indirectly, any valid claim of
 25 the '208 patent either literally or under the doctrine of equivalents; (4) that the Court declares this
 26 case exceptional under 35 U.S.C. § 285 and award Hologic its costs, expenses, and reasonable
 27 attorneys' fees; and (5) that the Court grant Hologic such other relief that the Court deems just and
 28 proper.

12. **Settlement and ADR**

2 Prospects for settlement, ADR efforts to date, and a specific ADR plan for the case,
 2 including compliance with ADR L.R. 3-5 and a description of key discovery or motions
 3 necessary to position the parties to negotiate a resolution.

4 The parties had an initial ADR Phone Conference on August 7, 2017. Dkt. 37. At this
 5 conference, the parties informed the Director of the ADR Program, Howard A. Herman, that the
 6 parties have a pending mediation with Magistrate Judge Sherry R. Fallon of District of Delaware
 7 and are planning to continue to work with Judge Fallon for their settlement discussions. As any
 8 significant events develop with regards to any settlement discussions, the parties plan to inform
 9 the Court.

13. **Consent to Magistrate Judge For All Purposes**

10 Whether all parties consent to have a magistrate judge conduct all further proceedings
 11 including trial and entry of judgment.

12 _____ YES NO

13. **Other References**

14 Whether the case is suitable for reference to binding arbitration, a special master, or the
 15 Judicial Panel on Multidistrict Litigation.

16 The parties do not believe that this case is suitable for reference to binding arbitration, a
 17 special master, or the Judicial Panel on Multidistrict Litigation.

18. **Narrowing of Issues**

19 Issues that can be narrowed by agreement or by motion, suggestions to expedite the
 20 presentation of evidence at trial (e.g., through summaries or stipulated facts), and any
 21 request to bifurcate issues, claims, or defenses.

22 Hologic believes that upon consideration of Minerva's motion for a preliminary
 23 injunction, the Court may wish to entertain an early motion for summary judgment of non-
 24 infringement and/or invalidity on asserted claim 13, which is currently the only asserted claim in
 25 the case.

26. **Expedited Trial Procedure**

27 Whether this is the type of case that can be handled under the Expedited Trial Procedure
 28 of General Order No. 64 Attachment A. If all parties agree, they shall instead of this
 29 Statement, file an executed Agreement for Expedited Trial and a Joint Expedited Case
 30 Management Statement, in accordance with General Order NO. 64 Attachments B and D.

1 The parties do not propose that this case proceed under the Expedited Trial Procedure of
 2 General order No. 64 Attachment A.

3 **17. Scheduling**

4 *Proposed dates for designation of experts, discovery cutoff, hearing of dispositive motions,
 pretrial conference and trial.*

5 Minerva's Position: The schedule for Minerva's preliminary injunction motion (Dkt. 35)
 6 is set forth in the Order re [39] Stipulation with Proposed Order dated August 15, 2017. Dkt. 39
 7 (Stipulation), 40 (Order). Minerva proposes that the case proceed pursuant to the Patent Local
 8 Rules and the Court's standing orders as set forth in Appendix A while the preliminary
 9 injunction motion is pending.

10 By proposing to defer the regular schedule pending the Court's decision on Minerva's
 11 preliminary injunction motion, Hologic seeks to delay the trial date for this case. But there is no
 12 reason for such delay, which Minerva opposes. Contrary to Hologic's assertion, there is no
 13 undue burden on Hologic (or the Court) to proceed with the case. First, the overlap between the
 14 normal case schedule and the preliminary injunction schedule is not onerous. For example, the
 15 first main deadline for Hologic in the case would be its Invalidity Contentions due on November
 16 6, 2017 under the Patent Local Rules, almost a month after Hologic's Opposition Brief for the
 17 preliminary injunction motion is due on October 11, 2017 under the current stipulated schedule.
 18 *See* Dkt. 39, 40. Further, the Claim Construction Hearing will be scheduled no earlier than April
 19 2008, four months after the hearing on the preliminary injunction motion. Second, because of
 20 the work that has been already done in the Delaware Action, discovery for the preliminary
 21 injunction is not as burdensome as if the parties have not litigated previously. Both parties have
 22 discovery from the Delaware Action (which completed fact discovery more than three months
 23 ago) and agreed to be able to use that discovery in this action, significantly reducing the burden
 24 on the parties for taking discovery for the preliminary injunction motion in this matter. Lastly,
 25 there is only one patent asserted in this case. Thus, proceeding with the normal schedule would
 26 not be unduly burdensome.

27 Hologic also asserts that the typical patent and claim construction disclosures may not be
 28 necessary because Minerva only asserts claim 13 of the '208 patent in the preliminary injunction

1 motion. But Minerva merely simplified the infringement issues for the preliminary injunction
 2 motion. It is likely that there would be additional claim terms in dispute that need construction
 3 for other claims to be asserted by Minerva in the case.¹ Moreover, the argument that Hologic
 4 may request early summary judgment on the issues of non-infringement and/or invalidity *after*
 5 the Court's ruling on the preliminary injunction motion is speculative and thus premature. In any
 6 event, such request may be made and be considered by the Court even if the regular case
 7 schedule proceeds. In sum, there is no reason to defer scheduling of the trial and proceed with
 8 the case pursuant to the Patent Local Rules and the Court's standing orders.

9 Hologic's Position: Conspicuously absent from Minerva's proposed case schedule is any
 10 trace of its preliminary injunction motion or the burdens imposed on the parties (and the Court) by
 11 its decision to seek extraordinary preliminary relief. In contrast, Hologic respectfully requests that
 12 the Court enter the proposed case schedule in Appendix B, which includes the schedule for the
 13 preliminary injunction proceedings² and defers many of the patent local rule disclosures until after
 14 the preliminary injunction motion is resolved. As Appendix B indicates, written and production
 15 discovery, as well as numerous fact and expert depositions,³ will be taken over the coming two
 16 months, culminating in motion practice and a hearing relating to Minerva's motion for a
 17 preliminary injunction ("PI"). While Minerva's motion should fail, it would place undue burden
 18 on Hologic to both defend against the PI and have to submit to the normal patent and claim
 19 construction disclosures required by our local practice.

20

21

22 ¹ Hologic proposes that Minerva should be ordered to serve its Infringement Contentions pursuant
 23 to the Patent Local Rules by September 21, 2017 even if the regular case schedule is deferred. *See*
 24 n.4 *infra*. But if their goal is to address all asserted claims in early summary judgment as Hologic
 25 contends, then Hologic should also be ordered to serve its Invalidity Contentions pursuant to the
 26 Patent Local Rules by November 6, 2017.

27 ² Appendix B reflects the dates contained in the parties' Stipulation and Proposed Order to modify
 28 certain dates in D.N. 40 to provide both sides with additional time in which to complete the PI
 briefing, which stipulation was also filed today. See Dkt. 41.

29 ³ Specifically, Minerva has submitted declarations by 10 declarants, including its liability expert,
 30 in support of its preliminary injunction motion. In addition, both named inventors will be deposed
 31 in the PI discovery proceedings.

1 Moreover, our typical patent and claim construction disclosures may be unnecessary and/or
 2 a waste of party resources since Minerva's PI motion asks the Court to rule on claim construction
 3 and make determinations on the patent merits for the sole asserted claim 13. It does not make
 4 sense for the parties to expend resources exchanging contentions and briefing issues of claim
 5 construction that may be obviated by the Court's ruling on Minerva's PI motion. In any event,
 6 once the Court has resolved Minerva's motion, the Court may be able to dispose of the case based
 7 on an early summary judgment motion of non-infringement and/or invalidity. Hologic therefore
 8 respectfully requests that, with the exception of Minerva's infringement contentions,⁴ the Court
 9 defer the local rule patent disclosures until after resolution of Minerva's PI motion. The reason
 10 Hologic proposes that Minerva should nonetheless be required to serve its infringement
 11 contentions (or, at a minimum, a binding identification of Minerva's asserted claims) is because
 12 this disclosure will significantly advance efficient case management⁵ and, given Minerva's
 13 significant work-up of claim construction and its infringement allegation in the PI motion, should
 14 not impose a significant burden on Minerva. In contrast, preparation of invalidity contentions
 15 would impose a significant burden on Hologic and it is unclear how such a disclosure would
 16 enable either party to file an early case-dispositive motion.

17 As plaintiff, when Minerva filed its Complaint, it could have sought an expedited schedule
 18 to trial. It did not. Instead, it brought a preliminary injunction motion that, by its very nature,
 19 disrupts the normal course and progress of a case. Minerva's suggestion that the parties have the
 20 bandwidth to litigate other issues in this case and that the case schedule should be business-as-
 21 usual inherently undermines its request for threshold emergency relief. Minerva cannot have it
 22 both ways. Having chosen to put the parties and the Court through this extraordinary preliminary

23
 24

⁴ Hologic proposes that Minerva identify any asserted claims for this litigation by serving its
 25 infringement contentions under the Local Patent Rules by September 21, 2017, the date that
 26 Minerva proposes.

27 ⁵ Specifically, Minerva's infringement contentions will enable Hologic to determine if it may
 28 bring an early summary judgment motion of non-infringement and/or invalidity after PI and, likewise, will inform Hologic's decision regarding whether to file *inter partes* review against the asserted '208 Patent.

1 injunction proceeding, it should not be surprised or dismayed that its PI motion would affect the
 2 rest of the case schedule.

3 For the foregoing reasons, Hologic proposes that the Court convene a case management
 4 conference after it has ruled on Minerva's motion for a PI. At that point, the parties and the Court
 5 will be in a better position to assess the most efficient manner in which to resolve this case and can
 6 adopt a sensible case schedule in light of the discovery, findings, and rulings that occur during the
 7 PI proceedings. *See Appendix B.*

8 **18. Trial**
 9 *Whether the case will be tried to a jury or to the court and the expected length of the trial.*

10 The parties have requested trial by jury. Trial is expected to take 8 days (excluding jury
 11 selection, opening, and closing) assuming the Trial Schedule and Timekeeping under the Court's
 12 Standing Order for Civil Jury Trials applies.

13 **19. Disclosure of Non-party Interested Entities or Persons**

14 *Whether each party has filed the "Certification of Interest Entities or Persons" required
 15 by Civil Local Rule 3-16. In addition, each party must restate in the case management
 16 statement the contents of its certification by identifying any persons, firms, partnerships,
 17 corporations (including parent corporations) or other entities known by the party to have
 either: (i) a financial interest in the subject matter in controversy or in a party to the
 proceeding; or (ii) any other kind of interest that could be substantially affected by the
 outcome of the proceeding.*

18 The parties have filed Certifications of Interested Entities or Persons Pursuant to Civil
 19 Local Rule 3-15. Dkt. 3 (Minerva); Dkt. 14 (Hologic).

20 Minerva confirms that it has no parent corporation, and no publicly held corporation
 21 owns 10% or more of Minerva's stock. Minerva also confirms that other than the named parties,
 22 there is no interest to report under Civil L.R. 3-15.

23 Hologic, Inc. restates that it has no parent company. It further restates that the Vanguard
 24 Group, Inc. and T. Rowe Price Group, Inc., each own ten percent (10%) or more of Hologic, Inc.'s
 25 stock.

26 Cytc Surgical Products, LLC restates that it is a wholly-owned subsidiary of Hologic, Inc.

27

28

1 **20. Professional Conduct**

2 *Whether all attorneys of record for the parties have reviewed the Guidelines for*
2 *Professional Conduct for the Northern District of California.*

3 All attorneys of record for the parties have reviewed the Guidelines for Professional
4 Conduct for the Northern District of California.

5 **21. Other**

6 *Such other matters as may facilitate the just, speedy and inexpensive disposition of this*
6 *matter.*

7 Pursuant to Patent L.R. 2-1(b), the parties have also met and conferred regarding the
8 following additional matters:

9 A. *Proposed modification of the obligations or deadlines set forth in the Patent Local*
10 *Rules to ensure that they are suitable for the circumstance of the particular case.*

11 The parties agree to follow the obligations under the Local Patent Rules. The parties,
12 however, disagree on the timing of these deadlines in light the pending motion for a preliminary
13 injunction. *See Appendices A & B.*

14 B. *The scope and timing of any claim construction discovery (including disclosure of*
15 *and discovery from any expert witness permitted by the court) and damages*
15 *discovery.*

16 Minerva's Position: Minerva's proposed case schedule (set forth in Appendix A)
17 addresses the timing of claim construction and damages discovery pursuant to the Patent Local
18 Rules.

19 Hologic's Position: Hologic believes that the Court's ruling on Minerva's motion for a
20 preliminary injunction may impact claim construction discovery. Hologic proposes that the
21 parties address the timing of claim construction and damages discovery after the preliminary
22 injunction proceedings. *See Appendix B.*

23 C. *The format of the Claim Construction Hearing, including whether the Court will*
24 *hear live testimony, the order of presentation, and the estimated length of the*
24 *hearing.*

25 The parties will abide by the procedures for the Claim Construction Hearing set forth in
26 this Court's Standing Order for Claim Construction in Patent Cases. The parties do not
27 anticipate requesting the Court to hear live testimony at the Claim Construction Hearing.

1 *D. How the parties intend to educate the court on the technology at issue.*2 The parties will abide by the procedures for a tutorial set forth in this Court's Standing
3 Order for Claim Construction in Patent Cases.4 *E. The parties shall provide the court with non-binding, good-faith estimate of the
5 damages range expected for the case along with an explanation for the estimates.
6 If either party is unable to provide such information, that party shall explain why it
7 cannot and what specific information is needed before it can do so. Such party
 shall also state the time by which it should be in a position to provide that estimate
 and explanation.*8 Minerva is unable to provide an estimate of the damages range at this time. Minerva will
9 need discovery from Hologic before it is able provide the estimate. Minerva expects that it
10 should be in a position to provide the estimate when its Damages Contentions are due pursuant to
11 Patent L.R. 3-8. *See Appendix A* (Proposed Case Schedule). Minerva also seeks its attorney's
12 fees and costs under 35 U.S.C. § 285.13 Hologic contends that Minerva is not entitled to any damages because Hologic does not
14 infringe any valid claim of the Patent-in-Suit. To the extent Minerva is found to be entitled to
15 any damages, such damages are limited to the only accused product, which was released in
16 February 2017. Further, Minerva has not yet shown that it has complied with the marking
17 requirements of 35 U.S.C. § 287, and thus may not be entitled to any pre-suit damages. As of
18 now, Minerva has not presented, nor is Hologic aware of, any evidence that Minerva has
19 complied with the patent marking requirement. Hologic is currently unable to provide a good-
20 faith estimate of the damages range expected for the case because Minerva has not yet provided
21 its damages contentions, including any basis for seeking lost profits or a reasonable royalty, and
22 Minerva has not produced documentation regarding patent marking. Hologic expects that it
23 should be in a position to provide an estimate when its Damages Contentions are due pursuant to
24 Patent L.R. 3-9. Hologic seeks its attorney's fees and costs under 35 U.S.C. § 285.

25

26

27

28

1 Respectfully submitted,

2 DATED: August 31, 2017

3 By: Vera M. Elson
Vera M. Elson

4 WILSON SONSINI GOODRICH & ROSATI PC
5 Attorneys for Plaintiff
6 MINERVA SURGICAL, INC.

7 DATED: August 31, 2017

8 By: Deborah E. Fishman
9 Deborah E. Fishman

10 ARNOLD & PORTER KAYE SCHOLER LLP
11 Attorneys for Defendants
12 HOLOGIC, INC. and CYTYC SURGICAL
13 PRODUCTS, LLC

14 In accordance with Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this
15 document has been obtained from any other signatory to this document.

16
17
18
19
20
21
22
23
24
25
26
27
28

14 By: /s/ Vera M. Elson
15 Vera M. Elson

1
2
APPENDIX A
MINERVA'S PROPOSED CASE SCHEDULE

3 Minerva's Proposed Deadline	4 Event	5 Applicable Rule or Order
6 Thursday September 21, 2017	7 Minerva's Disclosure of Asserted Claims and Infringement Contentions; Document Production Accompanying Disclosure	8 Patent L.R. 3-1, 3-2
9 Friday, September 29, 2017	10 Rule 26(a)(1) Initial Disclosures	11
12 Monday October 9, 2017	13 Last Day to Submit Proposed Modification to the ESI Order; Last Day to Submit Proposed Protective Order	14 Standing Order for E- Discovery and Email Discovery in Patent Cases
15 Friday October 27, 2017	16 Last Day to Join Parties and Amend the Pleadings Without Leave of Court	17
18 Monday November 6, 2017	19 Hologic's Invalidity Contentions; Document Production Accompanying Invalidity Contentions	20 Patent L.R. 3-3, 3-4
21 Monday November 20, 2017	22 Exchange of Proposed Terms for Construction	23 Patent L.R. 4-1
24 Monday December 11, 2017	25 Exchange of Preliminary Claim Construction and Extrinsic Evidence	26 Patent L.R. 4-2
27 Tuesday December 26, 2017	28 Minerva's Damages Contentions	29 Patent L.R. 3-8
30 Friday January 5, 2018	31 Joint Claim Construction and Prehearing Statement	32 Patent L.R. 4-3
33 Thursday January 25, 2018	34 Hologic's Responsive Damages Contentions	35 Patent L.R. 3-9
36 Monday February 5, 2018	37 Completion of Claim Construction Discovery	38 Patent L.R. 4-4
39 Monday February 19, 2018	40 Minerva's Opening Claim Construction Brief	41 Patent L.R. 4-5(a); Standing Order for Claim Construction in Patent Cases
42 Monday March 5, 2018	43 Hologic's Responsive Claim Construction Brief	44 Patent L.R. 4-5(b); Standing Order for Claim Construction in Patent Cases

Minerva's Proposed Deadline	Event	Applicable Rule or Order
Friday March 12, 2018	Minerva's Reply Claim Construction Brief	Patent L.R. 4-5(c); Standing Order for Claim Construction in Patent Cases
Friday March 30, 2018	Tutorial	Standing Order for Claim Construction in Patent Cases; <i>Subject to the Court's schedule</i>
Friday April 6, 2018	Claim Construction Hearing	Patent L.R. 4-6; Standing Order for Claim Construction in Patent Cases; <i>Subject to the Court's schedule</i>
Friday July 13, 2018	Close of Fact Discovery	
Friday August 10, 2018	Opening Expert Reports	
Friday September 7, 2018	Rebuttal Expert Reports	
Friday October 5, 2018	Close of Expert Discovery	
Friday November 2, 2018	Deadline to File Dispositive Motions; Deadline to File <i>Daubert</i> Motions	
Thursday December 13, 2018	Hearing on dispositive and <i>Daubert</i> motions	<i>Subject to the Court's schedule</i>
Tuesday January 8, 2019	Last day to meet and confer about preparation of the joint trial materials	Standing Order for Civil Jury Trials
Tuesday February 7, 2019	Pretrial Filings	Standing Order for Civil Jury Trials
Thursday February 21, 2019	Pretrial Conference	Standing Order for Civil Jury Trials; <i>Subject to the Court's schedule</i>

1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28	Minerva's Proposed Deadline	Event	Applicable Rule or Order
	Monday March 11, 2019	Jury Trial	Standing Order for Civil Cases; <i>Subject to the Court's schedule</i>

1
2
APPENDIX B
HOLOGIC'S PROPOSED CASE SCHEDULE

3 4 Event	5 6 Deadline	7 8 Authority
5 6 Parties propound document requests and interrogatories	7 8 Aug. 16, 2017	9 10 Order re Stipulation (Docket No. 40)
7 8 Parties respond to document requests and interrogatories, and complete production of documents	9 10 Sept. 7, 2017	11 12 Order re Stipulation (Docket No. 40)
10 11 Defendants take depositions of witnesses	12 13 Sept. 14 to Oct. 6, 2017	14 15 Order re Stipulation (Docket No. 40); Stipulation and Proposed Order (Docket No. 41)
12 13 Minerva's Disclosure of Asserted Claims and Infringement Contentions; Document Production Accompanying Disclosure	14 15 Thursday September 21, 2017	16 17 Patent L.R. 3-1, 3-2
15 16 Defendants' Opposition Brief	17 18 Oct. 20, 2017	19 20 Stipulation and Proposed Order (Docket No. 41)
18 19 Plaintiff takes depositions of witnesses	20 21 Oct. 20 to Nov. 10, 2017	22 23 Stipulation and Proposed Order (Docket No. 41)
20 21 Plaintiff's Reply Brief	22 23 Nov. 22, 2017	24 25 Stipulation and Proposed Order (Docket No. 41)
22 23 Hearing on Plaintiff's Motion for Preliminary Injunction	24 25 December 14, 2017 at 10:00 a.m.	26 27 Order re Stipulation (Docket No. 40)
24 25 Further Case Management Conference	26 27 At the Court's convenience after its ruling on Minerva's Motion for a Preliminary Injunction	28
26 27 Hologic's Early Motion for Summary Judgment on Non-Infringement and/or Invalidity	28 TBD	